

REMARKS

Initially, Applicants have amended claims 169, 183, 185, 194, 251-258, 260-261, and 263 to more accurately claim the present invention and not for any reason related to , patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the January 16, 2003 Office Action have been overcome and should be withdrawn.

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I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed stationary comprising at least one machine recognizable feature, which may be one of various embodiments including, but, not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material related to the information contained in the printed stationary is displayed. Importantly, the present

invention is designed to allow a user to access programming material related to the printed stationary.

II. THE EXAMINER'S REJECTIONS

5 The Examiner rejected claims 168-173, 176-178, 195-196, 220, 229-232, 237-239, 242, 253, 258, and 260-263 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Fields U.S. Patent
10 No. 4,481,412 (hereinafter referred to as "Fields"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature on stationary to display information on the display of a portable handset. However,
15 the Examiner admitted that:

 "Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to
20 the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the

coded signal." (January 16, 2003 Office Action Summary, p. 3, paragraph 4).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means
5 that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/
10 sound/pictorial/electronic/media data" on a "television/workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention:

15 "in order to provide the user a flexibility [sic] in viewing his/her desired/requested information ... and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al."
20 (January 16, 2003 Office Action Summary, pp. 3-4, paragraph 4).

Also, the Examiner rejected claims 174, 175, 180-181, 183, 189-190, 192-193, 214-219, and 222-223 under 35 U.S.C.

§ 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim 168" in view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec et al. U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall and Fields fail to teach online or home shopping and a cable television data link, and argued that these features are disclosed by Roberts. According to the Examiner, the combination of Roberts with Withnall and Fields would have been obvious and would provide:

"a faster internet system due to the benefit of cable television transmitting/conducting communication capability. Furthermore, such modification would have been an obvious extension as taught by Withnall et al./Fields to provide the user [with] an alternative way of conducting the shopping at his/her convenience." (January 16, 2003 Office Action Summary, p. 4, paragraph 5).

Moreover, the Examiner admitted that Withnall, Fields, and Roberts all fail to disclose an Integrated Service Digital Network ("ISDN") data link which, according to the Examiner, is disclosed by Malec. In the opinion of the Examiner, the combination of Malec with Withnall, Fields, and Roberts would have been obvious for providing:

"a more accurate and faster system due to the benefit of ISDN networking line[s]. Furthermore, such modification would have been an obvious extension as taught by Withnall et al./Fields/Roberts and would have been merely a substitution of equivalent[s]." (January 16, 2003 Office Action Summary, p. 5, paragraph 5).

Next, the Examiner rejected claims 179, 182, 184, 186-188, 191, 194, 199-201, 203-204, 209-210, 213, 221, 224-228, 236, 241, 243-245, 256, and 259 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claims 168 and 258" in view of Bravman et al. U.S. Patent No. 5,401,944 (hereinafter referred to as "Bravman"). The Examiner admitted that Withnall and Fields fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of Withnall, Fields, and Bravman would have been obvious for providing:

"a more compact system wherein the portable handheld communication device can be carried along with the user without causing any inconvenience, and thus providing a more user-friendly system. Furthermore, such modification

would have been an obvious extension as taught by
Withnall et al/Fields." (January 16, 2003 Office
Action Summary, p. 6, paragraph 6).

Also, the Examiner rejected claims 197, 202, and 205
5 under 35 U.S.C. § 103(a) as being unpatentable over
Withnall as modified by Fields "as applied to claim 168" in
view of Waterbury German Patent No. DT 24 52 202 A1
(hereinafter referred to as "Waterbury"). The Examiner
admitted that Withnall and Fields fail to teach an
10 invisible machine recognizable feature, which is argued to
be taught by Waterbury. The Examiner asserted that the
combination of Waterbury with Withnall and Fields would
have been obvious for providing:

"a greater security system [sic] wherein the data
15 , recorded in the machine recognizable feature is
invisible to [the] naked eye, and thus preventing
an unauthorized individual(s) from manipulating
the data. Furthermore, such modification would
, have been an obvious extension as taught by
20 Withnall et al/Fields." (January 16, 2003 Office
Action Summary, p. 6, paragraph 7).

Additionally, the Examiner rejected claims 198 and 212
under 35 U.S.C. § 103(a) as being unpatentable over
Withnall as modified by Fields "as applied to claim 168" in

view of Tannehill et al. U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall and Fields fail to teach a magnetic code strip, which is argued to be taught by Tannehill.

5 According to the Examiner, the aforementioned combination would have been obvious for providing Withnall and Fields with an alternative method for encoding data. "Furthermore, such modification would have been merely a substitution of equivalents for storing data." (January 16,

10 2003 Office Action Summary, p. 7, paragraph 8).

Also, the Examiner rejected claims 206-208 and 211 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim 168" in view of Schach et al. U.S. Patent No. 5,397,156

15 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall and Fields fail to teach a watermark, which is argued to be taught by Schach. In the Examiner's opinion, the combination of Schach with Withnall and Fields would have been obvious for aesthetic purposes.

20 "[S]uch modification would have been an obvious extension as taught by Withnall et al/Fields." (January 16, 2003 Office Action Summary, p. 8, paragraph 9).

The Examiner then admitted that Withnall, Fields, and Schach fail to teach an invisible watermark, which is

argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, and Waterbury would have been obvious for providing:

5 "a greater security system [sic] wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, and thus preventing an unauthorized individual(s) from manipulating the data. Furthermore, such modification would have been an obvious extension as taught by
10 Withnall et al./Fields/Schach et al." (January 16, 2003 Office Action Summary, p. 8, paragraph 9).

Also, the Examiner rejected claims 185, 233-235, 240-241, 246-252, 254-255, and 257 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as
15 applied to claim[s] 168 and 301" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall and Fields fail to teach a display unit comprising a "personal planner/phone/pager," which is argued to be taught by
20 Morales. In the Examiner's opinion, combining Withnall, Fields, and Morales would have been obvious to provide:

"the user with the flexibility of selecting his/her desired display unit that is most convenient to [sic] his/her needs, thus providing

, a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields." (January 16, 2003 Office Action Summary, p. 9, paragraph 10).

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III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

The Examiner rejected claims 168-173, 176-178, 195-196, 220, 229-232, 237-239, 242, 253, 258, and 260-263 under 35 U.S.C. § 103(a) as being unpatentable over
10 Withnall in view of Fields. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall and Fields. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must
15 exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d
20 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall and Fields exists.

5 "Standing on their own, these references provide
no justification for the combination asserted by
the Examiner. "Obviousness cannot be established
by combining the teachings of the prior art to
produce the claimed invention, absent some
teaching or suggestion supporting the
combination. Under section 103, teachings of
references can be combined only if there is some
suggestion or incentive to do so." ACS Hospital
10 Systems, Inc. v. Montefiore Hospital, 732 F.2d
1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir.
1984) (emphasis in original).

The Examiner contended that it would have been obvious
15 to combine the teachings of Withnall and Fields to arrive
at the various embodiments of Applicants' invention. Yet,
the Examiner has cited only purported benefits of this
combination without pointing to what motivation is provided
by the references themselves. Applicants submit that no
20 combination of these references would have been obvious to
one of skill in the art at the time of Applicants'
invention. Specifically, Withnall discloses a system for
easing the examination of commuter tickets for validity.
This purpose is far removed from the intent of the training
25 system disclosed by Fields. The training system of Fields
is used to provide a user with audio/visual output from a
videodisc player coinciding with material presented in a
training manual. The differing purposes of these
references have no overlap in use, and therefore, would not
30 provide one skilled in the art with a motivation or

suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall and Fields in any combination.

5 Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v.
10 Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co.
15 v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199, (Fed. Cir. 1983):

20 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

25 Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No

such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to
5 combine Withnall and Fields, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected claims. Withnall discloses a machine capable of scanning a bar code on a commuter
10 ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system reading a bar code on a training manual for playing corresponding material from a videodisc. Applicants respectfully submit that the combination of
15 Withnall and Fields cannot be successfully combined to disclose the means for accessing programming material associated with a database or the printed stationary having a machine recognizable feature of the claimed invention. Importantly, claims 168, 258, and 261 all disclose the
20 accessing of programming material resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently

updated version of the associated information (or programming material) upon scanning a stationary item. This is not possible with the combination of Withnall and Fields. Any attempt of implementing the videodisc player of Fields with Withnall would require the videodisc player to be located on a vehicle, e.g., a bus. Therefore, anytime information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such material.

Additionally, the stationary having a machine recognizable feature as claimed is not disclosed within the combination. The Examiner claims that Withnall discloses a

printed stationary having a machine recognizable feature. Applicants respectfully submit that stationary is not even mentioned within Withnall. Applicants can only assume that the Examiner has confused the commuter "stations" with the
5 intended meaning of stationary in the present invention. Applicants have intended stationary to refer to a supply, paper or otherwise, that can be printed or written on for correspondence or recordation purposes. Such supplies may include, but are not limited to, letterhead paper,
10 envelopes, notepads, journals, invitations, greeting cards, postcards, business cards, resume paper, etc. Withnall, which discusses commuter ticketing systems, naturally does not disclose any such items, and therefore cannot be used to cover the stationary of the claimed invention.

15 In sum, any attempt to combine Withnall and Fields to create the present invention would be unsuccessful and fail to provide the flexible, updateable system including a system for obtaining and surveying correlated programming material of the claimed invention as opposed to a
20 comparison of the identity of a printed code with a code stored in a database. Moreover, the dynamic programming material and the stationary comprising a machine recognizable feature of the claimed invention are not disclosed by the combination of these references.

In view of the foregoing, base claims 168, 258, and 261 cannot be unpatentable over Withnall and Fields. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base
5 claims. Therefore, these dependent claims are also not unpatentable over these references.

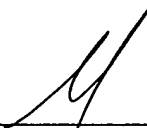
In all subsequent rejections, the Examiner noted the deficiencies of the Withnall and Fields combination regarding matter disclosed in dependent claims and appended
10 various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales to the combination in order to provide the additional features of the dependent claims. However, the combination of Withnall and Fields has been shown to be not only improper, but also
15 to lack the disclosure of each and every element of the base claims. Because this combination is improper and incomplete, any further combination of references with Withnall and Fields would also be improper. Thus, Applicants respectfully submit that all remaining
20 rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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